

PATENT APPLICATION

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December 17, 2002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Conklin, Darrell C. et al.
Application No.: 09/186,642
Filed : November 4, 1998
For : A HUMAN 2-19 PROTEIN HOMOLOGUE, Z219C

Examiner : Elaine Lazar-Wesley, Ph.D
Art Unit : 1642
Docket No.: 97-64
Date : December 17, 2002

Commissioner for Patents
Washington, D.C. 20231

RESPONSE

Sir:

In conjunction with the Request for Continued Examination being filed for this application, Applicants are filing this response in order to present new arguments to address the outstanding rejections for this application, as set forth in the Advisory Action dated June 10, 2002. The present response is accompanied by a request for a 4 month extension of time, pursuant to MPEP 710.02(e) and 37 CFR §1.7, from August 18, 2002 to December 18, 2002, so

that the present response can be properly filed. Applicants respectfully request consideration of the following remarks.

REMARKS

Reconsideration in view of the following remarks is respectfully requested. Claims 11-14 and 16-21 have been withdrawn from consideration. Claim 26 has been allowed. Claims 2, 3, 5, 22 and 24 have been rejected.

A. Rejection under 35 U.S.C. 101, first paragraph (utility)

In the Advisory Action dated June 10, 2002, the Examiner has indicated that the declaration submitted by Applicants with the Amendment and Response dated June 13, 2002 is "not deemed persuasive to overcome the rejections of record of claims 2, 3, 5, 22 and 24 under 35 USC 101 and 112, first paragraph" on the ground that "the more precise data about mapping the z219c at chromosome 3p14.2 were not presented in the specification as filed, and they do not flow from the specification."

Contrary to the assertions of the Examiner, the information discussed in the Amendment and Response dated June 13, 2002 ("Amendment and Response") and the accompanying Declaration of Theodore E. Whitmore Under 37 CFR 1.132 ("Whitmore Declaration") clearly support a utility for the present invention that is disclosed in the application as filed. In particular, the application as filed discloses that z219c maps to the 3p21.1-p13 region of chromosome 3 and that the genes associated with various human disorders, including a number of human cancers, map to this region of chromosome 3. (See, page 71, line 33 to page 73, line 35) The Amendment and Response and Whitmore Declaration provide further verification for this utility disclosed in the application as filed. In particular, these documents indicate the location of a specific locus for the z219c gene in the previously disclosed region of chromosome 3. In addition, these documents provide further support for the disclosure in the application as filed that genes associated with various human disorders, including a number of human cancers, map to the 3p21.1-p13 region of chromosome 3 as well as to the specific locus for the z219c gene in the previously disclosed chromosome 3 region. It is not true, as stated by the Examiner, that the more precise mapping data for z219c does "not flow from the specification." Rather, the

Amendment and Response and Whitmore Declaration simply provide support for the utility disclosed in the application as filed.

In view of the foregoing, it is clear that the claims under consideration meet the requirements of 35 U.S.C. 101. Therefore, the Examiner's rejection of the claims under 35 U.S.C. 101 should be withdrawn.

(B) Rejection under 35 U.S.C. §112, first paragraph (utility)

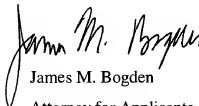
Claims 2, 3, 5, 22 and 24 have also been rejected under 35 U.S.C. §112, first paragraph on the ground that the claims are not supported by a specific or well-established utility.

Clearly, as discussed above, the specification does provide a specific and well-established utility for the claimed invention. Consequently, the rejection under 35 U.S.C. §112, first paragraph, of Claims 2, 3, 5, 22 and 24 should be withdrawn.

Early reconsideration and allowance of the pending claims is respectfully requested. If the Patent Examiner believes that a telephone interview would expedite prosecution of this patent application, please call the undersigned at (206) 442-6568.

Respectfully Submitted,

Darrell C. Conklin



James M. Bogden

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Enclosures:

Petition and Fee for 4 Month Extension of Time (in duplicate)

Postcard

Power of Attorney